

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:	:
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John J. Loy	: Group Art Unit: 3692
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Appln. No.: 10/085,977	:
	: Examiner: F. Poinvil
Filed: February 28, 2002	:
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For: Trade Receivable Processing Method	:
and Apparatus	:
	:
Mail Stop AF	
Commissioner for Patents	
P.O. Box 1450	
Alexandria, VA 22313-1450	

**REQUEST FOR PRE-APPEAL BRIEF CONFERENCE**

Pursuant to the Pre-Appeal Brief Conference Pilot Program announced in the Official Gazette, Applicants hereby request a pre-appeal brief conference in the above-referenced case.

This application is appropriate for a pre-appeal brief conference. A brief history of this application and why Applicants believe that an appeal will succeed are set forth below.

This application was filed over five years ago on February 28, 2002. On December 24, 2003, an initial office action was issued rejecting twenty-five (55) claims under 35 U.S.C. §103(a) as being unpatentable over Reifer (U.S. Patent No. 6,421,727) in view of Ginter (U.S. Patent No. 6,658,568). Applicant subsequently overcame these references. On December 17, 2004, an office action was issued rejecting twenty-five (55) claims under 35 U.S.C. §103(a) as being unpatentable over Thomas (U.S. Patent No. 6,173,272) in view of Field (U.S. Patent No. 6,073,104). On November 15, 2005, the Examiner issued a Notice of Allowance allowing claims 1-18, 20-24 and 26-27 based on Applicant's previous amendments. However, Applicant filed an RCE along with an IDS disclosing references for consideration by the Office. Unexpectedly, on June 16, 2006, however, the Office issued a rejection of all pending claims under 35 U.S.C. §103(a) as being unpatentable over Tarter (U.S. Patent No. 5,550,734) in view of Field (U.S. Patent No. 6,073,104). On November 28, 2006, Applicant met with the Examiner who suggested language to overcome the cited

references. Applicant submitted a response making the suggested amendments, but again the Office rejected the claims based on Tarter and Field.

Despite detailed amendments to the claims to distinguish this application from the cited references, the Office continues to reject all claims on a basis that is certain to be overturned on appeal. Currently, claims 1-18, 20-24, 26 and 27 stand rejected under §103(a) as being unpatentable over Tarter in view of Field. Rather than further time being spent addressing the claim rejections, Applicants have elected to pursue the new pilot program.

I. FAILURE TO CONSIDER INFORMATION DISCLOSURE STATEMENT

At the outset, Applicant disputes the Examiner's contention that the Applicant's failure to provide "explanations" regarding the relevance of cited references enables the Office to not consider the references. In particular, Applicant submits that it filed an RCE to expressly reopen prosecution so that the Office could formally consider references that may be material to the patentability of the pending claims. However, Applicant respectfully submits that it is not under any obligation pursuant to any rule or statute (including, for example, 37 C.F.R. §1.98) to provide an explanation of references submitted in an IDS, and thus respectfully requests that the references be formally considered and entered into the record. While Applicant does not believe that any of the references submitted actually affect the patentability of the pending claims, Applicant nonetheless submitted the references to the Office because of its ongoing duty to disclose to the Office information that may be material to patentability of its pending claims.

II SUBSTANTIVE REJECTIONS

As stated in MPEP § 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or

suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Regarding claims 1-18, 20-24 and 26-27, the Examiner alleges that Tarter discloses a "computerized healthcare accounts receivable purchasing collections, securitization and management system and method." The Examiner also alleges that the system and method "comprise receiving data comprising an invoice with payable and receivable information from a first participant involved in a transaction and storing the information in a receivable clearinghouse and generating electronic invoice information in response to the invoice received from the first participant." The Examiner also alleges that "[t]he claimed participant being a healthcare provider and the claimed receivable clearinghouse being the 'Pharmacy Fund, Inc.' (PFI) of the system of Tarter." The Examiner also alleges that "[s]ince the PFI obtains receivables, it would have been obvious to one of ordinary skill in the art that the receivables were offered for sale to third parties over a receivable marketplace associated with the receivable clearinghouse or PFI [the System Operator] wherein the receivable marketplace being accessed by a receivable trading apparatus." The Examiner also alleges that "[i]n any event, Field discloses a system and method for facilitating the selling and purchasing of a receivable."

However, Applicant respectfully submits that neither Tarter nor Field -- alone or in combination -- teaches or suggests any feature or functionality comprising the step of "offering the receivable for sale to third parties over a receivable marketplace associated with the receivable clearinghouse, the receivable marketplace being accessed by a receivable trading apparatus," as expressly recited in independent claim 1.

Regarding Tarter, Applicant respectfully disagrees with the Examiner allegation that because the PFI obtained a receivable, it would have been obvious to one of ordinary skill in the art that the receivable was offered for sale to third parties over a receivable marketplace. In particular, Applicant respectfully submits that there is no teaching or suggestion in Tarter that any receivable is offered to *third parties*. Tarter merely discloses that only the PFI -- the operator of CHARMS -- can decide whether it wants to purchase a receivable. Accordingly, Applicant respectfully submits that Tarter fails to teach or suggest the specific step

of “offering the receivable for sale to third parties over a receivable marketplace associated with the receivable clearinghouse, the receivable marketplace being accessed by a receivable trading apparatus,” as expressly required by claim 1.

Similarly, Applicant respectfully submits that Field does not teach or suggest the specific step of “offering the receivable for sale to third parties over a receivable marketplace associated with the receivable clearinghouse, the receivable marketplace being accessed by a receivable trading apparatus.” Rather, Field merely teaches a computerized system that will allow healthcare providers to access the commercial paper market by selling their patient claims to asset backed commercial paper conduits. *See* Abstract, Filed patent. Applicant respectfully submits that the commercial paper market disclosed by Field is not “a receivable marketplace associated with the receivable clearinghouse,” as required by pending claim 1.

Further, Applicant respectfully submits that the Examiner has failed to set forth a proper motivation for combining Tarter and Field to achieve the claimed invention. In particular, Applicant respectfully submits that the Examiner has not demonstrated why one of ordinary skill in the art would be motivated to incorporate Field’s access to the commercial paper market with Tarter’s system and method that only enables the PFI to purchase receivables. Applicant respectfully submits that Tarter’s system and method for allowing a lone system operator (e.g., PFI) to purchase a receivable would not benefit from -- and indeed is incompatible with -- Field’s system and method for providing access to the commercial paper market.

Accordingly, for at least the reasons set forth above, Applicant respectfully submits that claim 1 is allowable over the cited references.

Regarding claims 14 and 20, these claims recite subject matter related to claim 1. Thus, the arguments set forth above with respect to claim 1 are equally applicable to claims 14 and 20. Accordingly, it is respectfully submitted that claims 14 and 20 are allowable over Tarter and Field for the same reasons as set forth above with respect to claim 1.

Regarding claims 2-13, 15-18, 21-24 and 26-27, these claims are dependent upon independent claim 1, 14 or 20. Thus, since independent claims 1, 14 and 20 should be allowable as discussed above, claims 2-13,

15-18, 21-24 and 26-27 should also be allowable at least by virtue of their dependency on independent claim 1, 14 or 20. Moreover, these claims recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

For these reasons, Applicants request an appeal conference be convened to advise Applicants whether the Office will 1) allow the present claims, 2) reopen prosecution and issue a new office action or 3) allow this case to proceed to appeal.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including without limitation appeal fees or extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,



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